REMARKS

1. Response to Amendment. Applicant thanks the Examiner for the indication of his withdrawal of the rejections under 35 USC 112 in connection with Claims 32, 33, 37-39, 53-55, 56, 60-62, 76-78, and 79.

With regard to Claims 46 and 69, Applicant submits herewith amended claims from which the phrase "but are not limited to" has been deleted. Accordingly, Claims 46 and 69 have been amended to overcome the rejection under 35 USC 112.

2. Claim Rejections 35 USC 112. Claims 1-79 are rejected under 35 USC 112, first paragraph, as failing to comply with the enablement requirement. In particular, the Examiner takes issue with the subject matter "champion/challenger." More particularly the Examiner takes issue with the results achieved using the champion/challenger approach, *e.g.* how is the term "effectiveness" defined. The Examiner has drawn Applicant's attention to page 27, lines 15-20 of the Specification, as well as page 22, lines 4-12 thereof.

In this regard, Applicant notes the following:

On page 27, Applicant states that "champion/challenger testing is where the end user can compare competing strategies in a statistically valid way so that the end user can determine which strategy produces the best results."

The method of champion/challenger testing involves applying competing strategies and comparing the results obtained "in a statistically valid way" to determine which strategy produces the best results. One skilled in the art would know how to compare strategies. This is especially true where the Applicant teaches that the results are to be compared in a statistically valid way. Statistics have long been known to be a tool for making comparisons. Thus, persons skilled in the art would have no trouble applying statistical

methodology to determine which of two strategies produces the best result, where the best result is the most desirable result as determined by the end user. This is so because the Applicant teaches that "champion/challenger testing is where the end user can compare competing strategies..."

With regard to the statement on page 22, Applicant is of the opinion that the Examiner has incorrectly required that the notion of effectiveness as embodied in the monitoring of hits be linked to a standard time frame. This is just not the case. It is clear from Applicant's statement that:

"An end user by means of a monitor 215 and a Web server 216 for ASP mode stress tests the rules, models, and strategies by passing a large number of transactions through the system, such as, for example, 10,000 records or transactions. A bulk test report 206 is generated for review. Similarly, predefined specific parts of rules, models, and strategies are monitored for hits. That is, the preferred embodiment of the invention tracks statistics on the rules, models, and strategies reflecting if the rules, models, and strategies were used and how many times."

Thus, it is clear that Applicant has set a standard, *i.e* that of the number of transactions run through the system, which in the example given by the Applicant is 10,000 records or transactions. It is irrelevant over what period of time these transactions occur because the test is based on volume, and is not a temporal test. There can be no doubt as to what Applicant means by effectiveness because a time base is not required as a standard for measuring hits, but rather a volume of transactions is required. Accordingly, Applicant deems it appropriate for the Examiner to withdraw the rejection herein. To assist the Examiner in considering the level of skill in the art and what a reasonably skilled person would do with regard to determining effectiveness of a particular strategy, Applicant includes herewith, extrinsic evidence in the form of an attachment comprising various dictionary definitions of the term "effectiveness," as well as a thesaurus citation.

3. Claim Rejections- 35 USC 103. Claims 1-2, 4-5, 8-10, 12-13, 16-17, 34-38, 40-47, 49-52, 57-61, 63-72, and 75 have been rejected under 35 USC 102 as being unpatentable in view of Courts *et al.*, in view of Harrison *et al.*

Applicant notes that the heading of the rejection is under 35 USC 103, although the Examiner indicates the rejection is under 35 USC 102 (b). Applicant believes that the heading is correct and that the citation of 35 USC 102 (b) is incorrect because the rejection is a compound rejection, *i.e.* based on a combination of references. Further, Applicant notes that the Examiner's citation of Harrison as comprising USPN 4,741,976 is incorrect and that the correct citation is indicated on the Examiner's 1449 Form, *i.e.* USPN 6,741,974.

The Examiner had previously allowed Claims 48 and 71 in view of Courts based on the use of champion/challenger techniques. Accordingly, Applicant's previous response did not address Courts in any great detail. Applicant will first address Harrison *et.al*, which is directed to the portion of Applicant's claims that concern the champion/challenger methodology. Applicant has reviewed Harrison carefully and finds Harrison to be an extreme example of a mixed methaphor, dealing with both a market in which worlds can purchase and sell information, where the rules have genetic code and evolve in accordance with Darwin's principles.

Of most interest in connection with the present invention is the provision of rewards and punishments in relation to the processing of the job. Harrison teaches that various agents of different strengths can be compared directly with respect to the job itself. This can be seen at step 805 and in connection with Col. 26; lines 35-46. However, the method in Harrison is concerned with agent technology based upon a market approach to determining a best suited agent. This contrasts with the claimed invention which is a decision system, as claimed by Applicant. The Examiner indicates that the motivation for combining Harrison with Courts would be to enable automatic and continued optimization or online adaptation of software to minimize down time and suboptimal

functioning... However, the invention is concerned with "returning a real-time decision in ASP mode to an end user" in a decision service.

Applicant has made a careful review of Courts and finds that Courts is concerned with a mechanism for allowing interaction in an enterprise among various services at various layers. A significant portion of Courts concerns a locking mechanism for avoiding contention and corruption of data. Further, Courts is primarily concerned with accessing legacy databases and other systems.

The Examiner has mapped various elements of Applicant's claims to Courts, but Applicant is of the opinion that this mapping is incorrect. For example, the Applicant's invention is concerned with a decision service for returning a real-time decision in ASP mode to an end user. Nowhere in Courts is a decision process outlined. In support of his position, the Examiner has referred to the fact that business rules are a portion of the Courts invention. In particular, the Examiner refers to the business layer 16 and business objects 20(*sic*). With regard to business objects, Applicant believes that the Examiner meant business objects 22.

Courts discusses the business layer, stating that it provides "business logic for the Web system." The Web system is the presentation system embodied in the Courts invention. Courts also indicates that the pages produced by the Web system can "utilize business rules in business layer 16 to make complicated decisions." Courts does not indicate how these business rules are used, what the business rules are, and what decisions are made by the business rules. Thus, the skilled person has no way of knowing what Courts is referring to, let alone practicing same.

Courts goes on to say that the business rules are provided in the business layer so that they are easy to change and that they can be "unit tested." Courts also indicates that the hub 10 uses profile information with regard to personalized content that can "utilize business rules in business logic layer 16." Again, Courts is silent as to how he would

use this information and what the business rules would do in connection with such information.

The only other mention of business rules in Courts is Courts' statement that the "transaction log events"... "can be as granular as events generated by individual business rule objects detailing their specific interactions with the request." This would tend to indicate that the business rules operate in connection with the interaction hub to manage enterprise web transactions.

None of the foregoing discusses a "decision service returning a real-time decision in ASP mode to an end user." In fact, Applicant cannot find in Courts any mechanism that meets the limitation of the Applicant's preamble. Because the preamble is accorded little weight, Applicant now moves onto applying the references to the elements in the body of Applicant's claim. In this regard, Applicant requires "linking to a first computer system having project design software... for designing rules, models, and/or strategies." Here, the Examiner relies upon the business layer and business objects (incorrectly identified by the Examiner as 20). Applicant can find nothing in Courts, let alone in the specific reference made by the Examiner, that indicates that the system is concerned with "project design software." Further, Applicant can find nothing with regard to such software being used "for designing rules, models, and/or strategies." Nowhere in Courts is there a discussion of models or strategies. Further, the discussion of rules in Courts is not concerned with a decision service, but with the operating of a communications hub for an enterprise.

Applicant teaches "passing control to a code generator server for generating code for use in production in said ASP environment." Here the Examiner refers to a presentation layer 14, and the fact that Courts has referred to an independent software vendor. Court's statement is that "integration layer 18 interfaces to enterprise space 26 that may include legacy applications and data and to independent software vendor (ISV) space 28 that may include various ISV applications..." This is the full extent of Court's explanation of the software. The Examiner's reliance on this to teach the person skilled

in the art "passing control to a code generator for generating code for use in production in said ASP environment" is incorrect.

Applicant teaches that "said code generator server generating strategy service software for installation on a decision server for executing said rules, models, and/or strategies." Here, the Examiner refers to presentation layer 14 and render/object engines 20. Again, there is no "strategy service software" found in Courts nor any discussion of anything similar to that. There is no "decision server" found in Courts, nor anything similar to that. Courts does not execute rules, models, and/or strategies in a decision service to return a real-time decision in ASP mode to an end user. Applicant can find no logical way to link the teachings in Courts cited by the Examiner, or anywhere else in Courts for that matter, to the claim limitations.

Applicant teaches, "sending input data to said decision server...for processing using said decision server." As mentioned, there is no decision server found anywhere in Courts. A person skilled in the art would have no way of learning this element from Courts.

Applicant teaches "said decision server processing said input data according to said installed rules, models, and/or strategies and creating corresponding output data." The Examiner places considerable emphasis on the fact that Courts provides for business rules. However, as noted above, these rules are provided pursuant to the operation of Courts' communications hub for an enterprise. Courts does not have a decisioning system. The rules in Applicant's invention are concerned with a decision server, which is nowhere found or suggested in Courts. Further, Applicant's invention operates upon rules, models, and/or strategies to create output data in response to input data by the use of a decision server. Again, there is no decision process found in Courts that involves a decision server.

As discussed above, the Examiner relies on Harrison to teach the use of a champion/challenger experiment. However, as noted above, Harrison is concerned with

an agent system. Thus, there is a mismatch between the references. Harrison is an agent system and the person skilled in the art considering an agent system would not look to an enterprise interaction hub to produce a decisioning system, nor would a person skilled in the art, who is aware of an enterprise interaction hub look to an agent based system to produce the claimed decisioning system. The Patent Office itself notes the distinction between these two arts, classifying them in separate classifications with no overlap among the classifications. Thus, in the Patent Office's opinion, the art is non- analogous and accordingly the combination would be improper because a person skilled in the art would not consider the non-analogous art.

To establish a *prima-facie* case of obviousness, the Examiner must meet three criteria:

1. The Examiner must show that there is a motivation to combine the references. Here the references are in different fields of art and therefore non-analogous. One skilled in the art would not consider these different fields of art in producing the claimed invention so that there is no motivation to combine them. Further, neither of the references are concerned with the problem addressed by the claimed invention, that is, providing a decision service. Courts is concerned with an enterprise hub, and Harrison is concerned with an agent-based architecture. Thus, there is no motivation in either document to produce a decisioning system, nor does either document teach Applicant's claimed decisioning system or lead one skilled in the art to produce same.

2. There must be a likelihood of success. Here, there is no likelihood that a communications hub, such as taught by Courts, would be of any use in combination with an agent architecture, such as taught by Harrison, to produce in any successful way Applicant's claimed invention. How would the person skilled in the art know the manner in which a simple communications hub for an enterprise Web system could be combined with an adaptive agent-based architecture without applying considerable skill that amounts to inventiveness?

3. Each and every element of the claimed invention must be found in the cited references. Here, Applicant has carefully noted above that the cited references are deficient in many ways in teaching the claim limitations. Nowhere in the cited art is a decision service taught, there is no concept of the use of project design software, neither of the references is concerned with designing rules, models, and/or strategies, there is no notion that the project design software includes a champion/challenger experiment for testing a strategy in connection with said software, there is no code generator server for use in production in an ASP environment, there is no code generator server for generating strategy service software for installation on a decision server, there is no decision server, and so on.

In view of the foregoing, Applicant is of the opinion that the combination of references cited by the Examiner fails to establish a *prima-facie* case of obviousness. Applicant's claimed invention is entitled to presumption of patentability and the burden is on the Examiner to establish the lack of patentability: it is not the Applicant's obligation to establish patentability because that is presumed. Here, Applicant is of the opinion that the Examiner has failed to establish the *prima-facie* case of obviousness based upon the references cited by the Examiner. Applicant respectfully requests that the Examiner carefully reconsider the cited references in view of Applicant's comments herein.

Should the Examiner deem it helpful, she is encouraged to contact Applicant's Attorney, Michael A. Glenn, at (650) 474-8400.

Respectfully Submitted,

Michael A. Glenn
Reg. No. 30,176

Customer No. 22862